

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

APPLE INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 22-1378-MN
v.	)	
	)	<b>JURY TRIAL DEMANDED</b>
MASIMO CORPORATION and	)	
SOUND UNITED, LLC,	)	
	)	
Defendants.	)	

**UNOPPOSED MOTION OF PLAINTIFF AND COUNTERCLAIM DEFENDANT  
APPLE INC. TO STAY CERTAIN PATENT COUNTERCLAIMS  
PENDING ITC DETERMINATION PURSUANT TO 28 U.S.C. § 1659**

Plaintiff and Counterclaim Defendant Apple Inc. (“Apple”) hereby respectfully moves, pursuant to 28 U.S.C. § 1659, to stay proceedings against Apple in the above-captioned case as to the five Masimo patents that are the subject of this motion until a parallel proceeding before the U.S. International Trade Commission (“ITC”) becomes final, including all appeals. *See, e.g., In re Princo Corp.*, 478 F.3d 1345, 1347 (Fed. Cir. 2007) (“We conclude that the district court erred under § 1659 when it did not stay the case until related proceedings before the Commission, including any appeals, become final.”); *In re Princo Corp.*, 486 F.3d 1365, 1367 (Fed. Cir. 2007) (denying petition for rehearing, and stating that in the decision under review, “[w]e construed the term ‘until the determination of the Commission becomes final’ in § 1659 to include any subsequent appeal periods”). Counsel for the parties conferred pursuant to D. Del. LR 7.1.1, and Defendant and Counterclaimant Masimo Corporation (“Masimo”) has indicated that it does not oppose the relief Apple seeks in this motion.

Apple brought this suit against Masimo and Sound United on October 20, 2022, accusing Masimo’s W1 watch of infringement of six utility patents (U.S. Patent Nos. 10,076,257, 10,627,783, 10,942,491, 10,987,054, 11,106,352, and 11,474,483). Apple filed a parallel suit

(Civil Action No. 1:22-cv-01377-MN) against the same defendants asserting infringement of four design patents (U.S. Patent Nos. D883,279, D947,842, D962,936, and D735,131).

On December 12, 2022, Masimo filed counterclaims alleging, among other things, that Apple Watch infringes ten Masimo utility patents: U.S. Patent Nos. 10,912,501 (“the ’501 Patent”), 10,912,502 (“the ’502 Patent”), 10,945,648 (“the ’648 Patent”), 10,687,743 (“the ’743 Patent”), 10,687,745 (“the ’745 Patent”), 10,722,159 (“the ’159 Patent”), 7,761,127 (“the ’127 Patent”), 8,190,223 (“the ’223 Patent”), 10,736,507 (“the ’507 Patent”), 10,984,911 (“the ’911 Patent”).

Previously, on June 29, 2021, Masimo filed an ITC complaint against Apple alleging violation of Section 337 of the Tariff Act of 1930, as amended, for infringement of the ’501, ’502, ’648, ’745, and ’127 Patents (collectively, “the ITC Asserted Patents”). *In the Matter of Certain Light-Based Physiological Measurement Devices and Components Thereof* - Investigation No. 337-TA-1276. All five of the ITC Asserted Patents are among the ten counterclaim patents brought by Masimo. Masimo accused Apple of infringement of the asserted patents by certain versions of Apple Watch, including “Apple Watch Series 6.” (Ex. A ¶ 2; *id.* at ¶ 39 (accusing “pulse oximetry functionality”).) Masimo also accuses Apple Watch Series 6 of infringement in the present action. (D.I. 15 ¶¶ 234–235 (accusing “measur[ing] blood oxygen saturation (i.e. pulse oximetry)”).)

28 U.S.C. § 1659(a) provides that “at the request of a party to the civil action that is also a respondent in the proceeding before the [International Trade] Commission, the district court shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission . . . .” Pursuant to § 1659(a), a stay must issue in a civil action in regards to claims for which the following three conditions are met: (1) the requesting party is a respondent in the

proceeding before the ITC; (2) the claims for which a stay is sought involve the same issues as those involved in the proceeding before the ITC; and (3) the request is timely (within 30 days of filing of the district court action). *Id.*

Each of the three conditions is satisfied here. The first condition is met because Apple is a respondent in an ITC investigation filed by Masimo. (Ex. A.) The second condition is met because the ITC Asserted Patents are also asserted in this action and the same products are involved in both proceedings. *See, e.g., Graphic Properties Holdings, Inc. v. Toshiba Am. Info., Sys., Inc.*, C.A. No. 12-213-LPS, 2014 WL 923314, at \*1 (D. Del. Mar. 5, 2014) (holding that a stay is mandated by § 1659 where the district court action and the ITC investigation involved the same asserted patent and accused products). The third condition is met because this motion is made within 30 days of the filing of Masimo's counterclaims, December 12, 2022.

For the foregoing reasons, Apple respectfully requests that the Court grant this unopposed motion and enter the attached proposed order to stay each of Masimo's Counterclaims Nos. 7, 8, 9, 11, and 13, which assert the '501, '502, '648, '745, and '127 Patents, until the ongoing ITC matter has concluded, including all appeals, for the patent asserted in the counterclaim. Apple further proposes that, within 14 days of the conclusion of the ITC matter, including all appeals, as to any one or more of the above patents, the parties shall file a joint status report notifying the Court of such conclusion and the patent(s) to which it applies, and propose how the Court should proceed as to such patent(s).

Respectfully submitted,

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